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Attorney Docket No.: 99.51

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3-20-03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Zecchino et al.

Serial No.: 09/995,358

Group Art Unit: 1615

Filed: November 26, 2001

Examiner: B. Fubara

For: GELLED AQUEOUS COSMETIC COMPOSITIONS

RESPONSE UNDER 37 CFR 1.116

Assistant Commissioner of Patents

Washington, D.C. 20231

Sir:

In response to the office action dated September 18, 2002, please enter the following remarks and the accompanying declaration. The response raises no new issues and is believed to place the application in condition for allowance, or in better condition for appeal should the final rejection be maintained.

I. Rejections under 35 USC §103(a)

A. Claims 1 and 3-11 remain rejected under 35 USC §103(a) as being unpatentable over Wheeler and Collin et al. In Applicants' last response, Applicants argued that Wheeler did not address the issue of incorporating acidic or electrolytic components into the biliquid foam-containing formula, and further teaches only traditional gelling agents, such as carboxomers, and not polymeric sulfonic acid. Applicants also argued that Collin did not provide the information from Wheeler, since that reference only prepared an emulsion in which a stable salicylic acid is present, did not disclose a biliquid foam containing dispersion, and did not disclose a polymeric sulfonic acid gellant for use in any kind of product. Thus, a crucial element of the claims, namely a polymeric sulfonic acid, is completely missing from both references.

Notwithstanding these arguments, the Examiner has maintained this rejection, based on the following arguments, quoted in pertinent part from the office action:

In cases where the compositions of prior art are used for the same purpose, in this instance, cosmetic, "it is *prima facie* obvious to combine two compositions each of which is taught in the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose...[T]he idea of combining them flows logically from their having been individually taught in the prior art." *In re Kerkhoven*...Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the teachings of Wheeler in the manner disclosed by Collin. One having ordinary skill in the art would have been motivated to prepare the composition of Wheeler *et al.* and incorporate the salicylic acid of Collin *et al.* wherein the salicylic acid is the active ingredient and further stabilizes the bi-liquid foam. The amount of bi-liquid foam of the instant invention overlaps with amount of the bi-liquid form [*sic*] disclosed by Wheeler *et al.* In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a *prima facie* case of obviousness exists. ... The invention is obvious over the prior art in the absence of a showing of unexpected result over the prior art.

Applicants believe the Examiner's arguments regarding the cited art to be incorrect.

Even assuming that there is motivation to combine the two references, one would not arrive at the present invention. All of the present claims, including those under this rejection, require the presence of an aqueous phase gelled by a polymeric sulfonic acid. If one combs through the teachings of both Wheeler and Collin, no mention of a polymeric sulfonic acid can be found anywhere in either document. It is axiomatic that establishment of a *prima facie* case of obviousness requires, *inter alia*, that prior art reference(s) teach or suggest all claim limitations. *In re Royka*, 180 USPQ 580 (CCPA 1974; emphasis added). In the utter absence of any teaching whatsoever of a polymeric sulfonic acid in either of the cited references, the Examiner cannot legally sustain the position that the combination of Wheeler and Collin render claims 1 and 3-11 obvious. Because of this fatal flaw in the Examiner's argument, the rejection of these claims based on Wheeler and Collin must be withdrawn.

B. Claims 1, 2 and 12-21 remain rejected under 35 USC §103(a) as being unpatentable over Wheeler and Collin in view of the Clariant product brochure. In their prior response, Applicants argued that the Clariant reference fails to address the issue of low pH and that one skilled in the art would have no expectation of success in formulating the combined compositions of Wheeler and Collin with the gellant in the Clariant product brochure. The Examiner has rejected this argument stating:

The Clariant brochure does teach that the polymeric sulfonic acid provides thickening even at low pH's and Wheeler teaches low pH. The brochure describes a product that is a good gelling agent or a thickening agent. One of skill or ordinary skill in the art would be motivated to try out the gelling agent in the brochure that is described as a good gelling agent or thickening agent and one that can thicken even at low pH's in emulsions. Emulsions are specifically mentioned in the brochure. The expectation of success is high since the specific agent thickens emulsions. Applicants provided no data that shows that the gelling or thickening agent disclosed in the brochure would not work in Wheeler or Collin or the combined formulation of Wheeler and Collin or comparative data between the prior art composition and the instant composition.

Again, it is believed that the Examiner's analysis of the teaching of the prior art is incorrect. While it is correct to state that the Clariant brochure discloses that the polymeric sulfonic acid can thicken emulsions at a low pH, the present compositions are not emulsions, nor are the compositions of Wheeler: they are biliquid foams dispersed in an aqueous gel. It is expressly stated in Wheeler that the foams are not emulsions (page 3, line 3), and the dispersion of an oil component in an aqueous gel does not make the composition as a whole an emulsion. It is, therefore, incorrect to state that the expectation of success is high, since the expectation of success is with respect to an emulsion, and not with respect to a formulation of the type disclosed in Wheeler or claimed in the present application. There is simply no expectation at all with regard to the Clariant product's being able to thicken the biliquid foam dispersion of Walker.

Thus, on this technical basis alone, the basis for the rejection is flawed.

The Examiner also asserts that there has been presented no comparative data provided between the present compositions and the prior art composition. Applicants note that prior comparisons have been made, in the form of the Matathia declaration previously submitted, that show that the traditional gellants of the prior art do not perform satisfactorily in a low pH composition, and therefore have shown that the polymeric sulfonic acids of the present claims do possess unexpected properties. To further buttress this already demonstrated assertion,

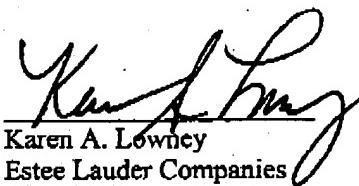
Applicants provide herewith a §132 declaration of James T. Harrison, one of the named inventors on the application. In this declaration, a comparison is made between the use of a carborner, one of the gellants recommended in Wheeler, and the use of a polymeric sulfonic acid, in the composition of Example 5 of Wheeler. To mimic the higher levels of salt required by the present claims and allegedly taught by Collin, sodium chloride is added to each composition to achieve a pH in each that is well below 7. As the declaration shows, the composition of the prior art, in which a carborner gellant is used, is unstable in comparison with the exact same composition in which the polymeric sulfonic acid gellant is used. This example bears out, with a direct comparison to the prior art composition, Applicants' assertion that the polymeric sulfonic acid is superior to the gellant disclosed by Wheeler in stabilizing the formulation. This superiority is

completely unexpected, and is neither taught nor suggested by any of the prior art references. In view of the arguments provided, and the unexpected superiority of the claimed formulations, withdrawal of the rejection of claims 1, 2 and 12-21 is respectfully requested.

CONCLUSION

The present claims are believed to be in condition for allowance, and prompt issuance of a Notice of Allowance is respectfully solicited. The Examiner is encouraged to contact the undersigned by telephone if it is believed that discussion will resolve any outstanding issues.

Respectfully submitted,



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